

Appl. No. : **10/550,132**
Filed : **April 28, 2006**

REMARKS

Claim 6 has been amended to include the features of Claim 11 and 14. Claims 11, 12, 14, and 20 have been canceled. Claims 15-19 have been canceled as being directed to a non-elected invention. Claims 21-24 have been added. Support for Claim 21 can be found at page 4, line 14, for example. Support for Claim 22 can be found in Examples 1-7 on pages 6-9, for example. Support for Claim 23 can be found in Examples 3-7, for example. Support for Claim 24 can be found in the last paragraph on page 4, for example. No new matter has been added. Applicant respectfully requests entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

Rejections of Claims 6-12 and 20 Under 35 U.S.C. § 102

Claims 6-12 and 20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Doelle et al (WO 03/072875 – US 2005/0121157 which is an English language equivalent thereof).

Claim 6 as amended herein include the features of Claim 14 which is not rejected on this ground, and therefore, the rejection of Claim 6 is moot. The rejection of Claim 14, now canceled, will be addressed insofar as applicable to the patentability of amended Claim 6. The rejections of Claims 7-10 are also moot at least due to their dependencies from Claim 6. The rejections of Claims 11, 12, and 20 are moot due to the cancelation of these claims.

Rejections of Claims 13-14 Under 35 U.S.C. § 103

Claims 13-14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Doelle et al in view of Hirabayashi et al (US 6,458,413). Claim 6 has been amended to include the features of Claims 11 and 14, and Claim 14 has been canceled.

The Examiner asserts that Doelle essentially teaches the claimed invention. Applicants respectfully disagree.

With regard to Claim 11, the Examiner asserts: "Since the references teach all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on."

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It is well established: "Inherency, however, may not be established by probabilities or possibilities. The fact that a given thing *may* result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (CCPA 1981) (quoting *Hansgird v. Kemmer*, 102 F.2d 212, 214, 40 U.S.P.Q. 665, 667 (CCPA 1939)).

Doelle states:

In this segment, relating to the stock production, the filler in the form of precipitated calcium carbonate (PCC) is added to the fiber preparation in such a manner that all fibers possess a more uniformly distributed PCC layer. This is due to the fact that the wood fibers or chemical pulp fibers are exposed to Ca(OH)_2 and everything is being mixed. The mixture is then exposed to CO_2 in a reactor where the CaCO_3 (PCCC)-crystals are formed.

Doelle, [0021]. As stated above, in *Doelle*, exposing the fibers to Ca(OH)_2 and CO_2 is required to perform chemical reaction to form fillers. See also paragraphs [0017] and [0034] to [0039]. Thus, in *Doelle*, at least a portion of the fillers is chemically bound to fiber pulps and has no zeta potential. Further, in the claimed invention, "[i]f two or more different fillers are added, the average grain size and zeta potential should be measured as the total values of the filler mixture" (last complete paragraph on page 3), and as clearly shown in Table 1 on page 11, even when PCC was used, the zeta potential was *not necessarily* 0 mV or above. Thus, in *Doelle*, there is the possibility that the zeta potential would be less than 0 mV. Accordingly, the inherency of "0 mV or above" is not established. The burden of showing the inherency still rests on the Examiner.

The Examiner further asserts that although *Doelle* does not teach deinked pulp, *Hirabayashi* teaches dry paper sludge such as deinked pulp. However, *Hirabayashi* does not recognize the problem in that "in offset printing, a high DIP content can cause blurred ruled lines and roughness on solid areas due to paper powder deposit" and "Among these problems, paper powder deposit not only reduces print quality, but it also affects the printing efficiency because a large amount of paper powder deposited on the blanket cylinders of the press prolongs the cleaning time for the cylinders." *Specification* p. 1, last par. Thus, *Hirabayashi* could not provide a solution to the problem of the high DIP content. As shown in Table 1 on page 11, for example, the claimed invention produces unexpected results commensurate in scope with Claim 6 as amended.

In view of the foregoing, Claim 6 could not be obvious over *Doelle* and *Hirabayashi*. Claim 13 also could not be obvious at least due to its dependency from Claim 6. Applicants respectfully request withdrawal of the rejections.

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New Claims 21-24

Claims 21 to 24 have been added. These claims further recite features which are not taught by Doelle or Hirabayashi, in addition to the distinguishing features defined in Claim 6.

For example, Claim 23 recites that the filler or fillers are contained in an amount of no less than 21 percent by weight as ash relative to the dry weight of the base paper. Doelle states: "The cited method can be utilized particularly advantageously in the production of newsprint, especially with an ash content of 5% to 20%, of SCA paper, ..." ([0019]). In view of the problem in that "increasing the filler content generally lowers the surface strength and tensile strength of paper and also reduces the thickness of paper" (*Specification* p. 2, 2nd par.), there is no rational reason to increase the ash to no less than 21%. Hirabayashi does not supply the deficiencies of Doelle.

Claim 24 recites that the clear coat is selected from the group consisting of oxidized starch, esterized starch, etherized starch, cationic starch, enzyme modified starch, aldehyde starch, hydroxyethyl etherized starch and other modified starches, carboxymethyl cellulose, hydroxyethyl cellulose, methyl cellulose, carboxyl modified polyvinyl alcohol, styrene-butadiene copolymer, polyvinyl acetate, vinyl chloride-vinyl acetate copolymer, polyvinyl chloride, polyvinylidene chloride, polyacrylic ester, and polyacrylamide. Hirabayashi teaches the use of polyvinyl alcohol (PVA), and Claim 24 excludes PVA. There is no rational reason to use materials other than PVA. Doelle does not supply the deficiencies of Hirabayashi.

Applicants respectfully submit that these claims are patentable.

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CONCLUSION

In light of the Applicant's amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. The grounds for rejection which are not discussed herein are moot and Applicants expressly do not acquiesce in the findings not separately addressed. Any alterations or characterizations made to the application or claims are being made to facilitate expeditious prosecution of this application, rather than conceding that previously pending claims are not patentable over the cited references. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims.

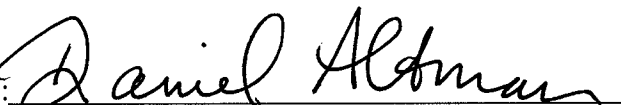
Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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